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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,361	11/28/2005	Torgny Lagerstedt	1501-1293	8955
466 7590 03/19/2007 YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			EXAMINER COOLEY, CHARLES E	
			ART UNIT	PAPER NUMBER
			1723	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/19/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	10/526,361		LAGERSTEDT ET AL.	
	Examiner		Art Unit	
	Charles E. Cooley		1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

FINAL OFFICE ACTION

Priority

1. Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d). All of the CERTIFIED copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

Drawings

2. The replacement sheet of drawings 28 FEB 2007 are approved.

Specification

3. The substitute abstract is acceptable.
4. The title is acceptable.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimball (US 920,481) in view of Berber et al. (US 4,262,841).**

The patent to Kimball discloses a rotor for a centrifuge comprising a plurality of

Art Unit: 1723

adjacent, concentrically stacked disc elements k provided with at least a centrally disposed hole (Fig. 3), said disc elements k having through openings L by means of which the disc elements k are slipped onto at least three essentially axially standing, circumferentially spaced, guide elements R, R' (see col. 2, lines 57-60 and col. 3, lines 21-24 which teaches any number of guide elements may be employed) for guiding the disc elements k circumferentially and radially, and said disc elements k being held together by end elements s^1 and s^2 at the ends of the stack of discs k, said guide elements being in the form of separate tensile rods R, R' which are disposed to cooperate with the end elements in such a manner that the end elements s^1 and s^2 are displaceable relative to each other when compressing the disc elements k, means N being arranged to lockingly engage the combined guidance and tensile rods to hold the disc elements k in a compressed state, wherein the through openings L in the disc elements k for the tensile rods are in the form of notches L radially directed from the central fluid inlet hole in the disc elements k as seen in Fig. 3; the tensile rods R, R' are inherently arranged upon slipping of the disc elements k onto the same, to be inclinable somewhat inwards towards the rotational center from one of the end elements s^2 to facilitate mounting by virtue of the rods being attached at one end only to the end element s^2 during assembly thereby permitting deflection of the unattached ends (at l and l' in Fig. 4) at least to some degree; that the end elements s^1 and s^2 have an outer diameter which is less than the outer diameter of the disc elements k as seen in Fig. 1. The patent to Kimball thus discloses all of the recited subject matter with the exception of the newly claimed disc elements being of conical shape.

Art Unit: 1723

The patent to Berber et al. discloses a rotor for a centrifuge comprising a plurality of adjacent, concentrically stacked disc elements 1 (col. 2, lines 67-68 and col. 3, lines 1-2) provided with at least a centrally disposed hole (proximate 6) and the disc elements being conical in shape; said conical disc elements 1 having through openings 6 by means of which the disc elements 1 are supported via a guide element; wherein the through openings 6 in the disc elements 1 are in the form of a notches 6 radially directed from the central hole in the disc elements 1 as seen in Figs. 2 and 5. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have substituted the disc elements of Kimball with the conical disc elements of Berber et al. for the purposes of enhancing the reliability of the solids separation, to reduce the amount of solids present in the flow of clarified liquid, and to improve the self-cleaning properties of the discs (col. 1, lines 43-47; col. 2, lines 4-8; and col. 3, lines 40-42).

Furthermore, it is noted that one of ordinary skill in the art would have recognized that a flat disc and a conical disc are all well known types of separation inserts used in the centrifugal separation art, and that such inserts are generally alternative mechanical structures used in centrifuge rotors of the type shown in the prior art and as claimed by applicant. Moreover, applicant's specification does not indicate that the type of disc element employed solves any stated problem or produces any new or unexpected result. Accordingly, it can be concluded that the particular type of disc element employed in the rotor would have been a matter of obvious design choice to one of

Art Unit: 1723

ordinary skill in the art and thus does not serve to patentably distinguish the claimed invention over the prior art. *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

Response to Amendment

7. Applicant's arguments with respect to the pending claims have been considered but are deemed to be moot in view of the new grounds of rejection necessitated by amendment.

8. Applicant's arguments filed 28 FEB 2007 have been fully considered but they are not deemed to be persuasive.

Applicant argues that the Kimball device is not suitable for separating gaseous material and the elements therein are not suited for stacking a great number of discs (whatever the scope of "great number" is). Applicant's position on this point is considered to be speculative attorney's argument unsupported by objective technical evidence on the issue. Arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Pearson*, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

Nevertheless, such an intended use (purifying a gas medium) has not been afforded any patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647; *In re Sebald*, 122 USPQ 527;

Art Unit: 1723

In re Lemin et al., 140 USPQ 273; *In re Sinex*, 135 USPQ 302; *In re Pearson*, 181 USPQ 641.

Applicant's unfounded position on the inability of the Kimball elements to adequately and tightly hold the discs together directly contradicts the teachings of Kimball set forth at col. 2, lines 64-74. The claimed structure of a central hole is shown both in the discs of Kimball and Berber et al. The intended use of said hole is not germane to patentability as noted above.

Applicant's comments on the use of the claimed invention to purify gas are noted, however, a recitation with respect to the material intended to be worked upon by a claimed apparatus (the gas in this instance) does not impose any structural limitations upon the claimed apparatus, which differentiates it from a prior art apparatus satisfying the structural limitations of that claimed. Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). Accordingly, the recitation of what particular substances are utilized during operation of the apparatus is not germane to the patentability of the apparatus itself. Since all of the claimed elements are met by the prior art applied above under 35 U.S.C 103, the rejection is considered proper.

Conclusion

9. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION. ANY RESPONSE FILED AFTER THE MAILING DATE OF THIS FINAL REJECTION WILL BE SUBJECT TO THE PROVISIONS OF MPEP 714.12 AND 714.13.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Cooley whose telephone number is (571) 272-1139. The examiner can normally be reached on Mon-Fri. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1723

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Charles" followed by a stylized flourish.

Charles E. Cooley
Primary Examiner
Art Unit 1723

15 March 2007